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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,476	05/24/2001	Yasuhiro Shinkai	Q64648	1262
7590 01/04/2006 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037			EXAMINER NGUYEN, TAN D	
			ART UNIT 3629	PAPER NUMBER
DATE MAILED: 01/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,476

Applicant(s)

SHINKAI, YASUHIRO

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/05 has been entered.

Claim Rejections - 35 USC § 112

2. Claim 6 recites the limitation "the order has been placed" in line 6. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 11 recites the limitation "the order has been placed" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 11, 13 (method¹), 6-9, 12 and 15 (apparatus¹), 10 (method²), 1-5, 16-18 (apparatus²), are rejected under 35 U.S.C. 103(a) as being unpatentable over TAMURA et al (US Patent 6,771,896), FUJI et al (US Patent 6,285,461) and DAWE (Article 9/29/98).

As for Independent method¹ claim 11, TAMURA et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of:

(a) transferring to a 1st printer (Fig. 3, 223 or Fig. Fig. 12, 130) ordered image data and order information, and

(b) transmitting, after the order has been placed, to a person (user or customer) who has placed the order and in the form of electronic mail (email), information (data) or messages about the completion of prints {see col. 13, lines 9-12 "*may transmit an **electronic mailing** telling completion of prints to the electronic mail address of the user*"}.

TAMURA et al discloses the claimed invention except for the type of transmitted information (data) in (b) wherein the information (data) containing thumbnail images corresponding to image data and order information which have been transferred to the image printer (or of (a) above).

However, on col. 12, lines 33-49, TAMURA et al teaches the concept that after the order has been placed, it's possible to confirm the contents of the order by selecting

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a preview mode on the camera, whereby thumbnail (tiny) images correspondent to images which prints are desired are displayed and the number of prints can be confirmed by the numeral displayed in the running state as shown in Figs. 12(a) and 12 (b). The confirmation of the contents of the order is inherently for the purpose of minimizing errors of printing the wrong prints (images or copies) or different from an image in which the user has desired.

FUJI et al is cited to teach concept of minimizing printing errors, an actual image printed out by the printer is different from an image which a user has desired, by having a preview function (previewing data generation system) to work along with the main computer (microcomputer) to provide the displaying of the preview data for reviewing prior to making a print or printing {see col. 1, lines 20-37, col. 3, lines 10-38, col. 11, lines 43-55, col. 12, lines 5-40, col. 13, lines 1-50, col. 14, lines 1-35}. It would have been obvious to modify the printing apparatus of TAMURA et al (Fig. 2, 220) to include preview function or (previewing data generation system) to work along with the main computer (microcomputer 222 of TAMURA et al) to provide the displaying of the preview data for reviewing prior to making a print or printing, thus minimizing printing errors {see col. 1, lines 28-35}. FUJI et al discloses that the preview image data can be modified from the print image such as reducing in size (1/3 or as desired), changing in resolution or color {see col. 19, lines 25-35, resolution or color {see Figs. 5A-5C, col. 13-14}}.

As for the new limitation of "prepared on the basis of high-precision image data" on the thumbnail images, this carries no patentable weight since the features of the

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images must be positively recited such as size, weight, shape, etc. and not how it's made. Furthermore, this is inherently included in the teaching of FUJI et al {see col. 2, col. 13, Figs. 5A-5C}. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information to high-precision image data if necessary if higher precision image data is critical and cost is secondary to quality.

DAWE is cited to teach the general concept of sending (transmitting), after the order has been placed, to a person (user or customer) who has placed the order, written confirmation containing detailed information about (1) the order, (2) price quotation, (3) any upgrades, etc., in time or immediately (next morning), for the benefits of minimizing errors or ironing out any errors and reassure customers of the order during the order time and before delivery (see page 2). It would have been obvious to modify the printing accept method/system of TAMURA et al /FUJI et al by sending/transmitting written confirmation containing detailed information about (1) the order, (2) price quotation, (3) any upgrades, etc., immediately prior to manufacturing, for the benefits of minimizing errors or ironing out any errors and reassure customers of the order during the order time and before delivery as taught by DAWE above. Clearly, it would have been obvious in view of the teaching of DAWE that the information (data) to the user in TAMURA et al /FUJI et al containing thumbnail images corresponding to image data and order information which have been transferred to the image printer prior to printing.

As for dep. claim 13 (part of 11), this is taught in TAMURA et al col. 13, lines 10-11.

As for independent apparatus¹ claim 6, which is the apparatus to carry out the independent method¹ of claim 11 above, the order acceptance machine is shown in Fig. 4 (or Fig. 12) wherein (a) the image printer is element (220 or 130), and (b) the electronic mail transmission means which communicates with the person who has placed an order and in the form of an electronic mail is shown described on col. 13, lines 10-13. As for the ordering in the form of an electronic mail, this is rejected for the same reason set forth in claim 11 above. As for the limitation of “prepared on the basis of high-precision image data” on the thumbnail images, this carries no patentable weight since the features of the images must be positively recited such as size, weight, shape, etc., and not how it’s made. Furthermore, this is inherently included in the teaching of FUJI et al {see col. 2, col. 13, Figs. 5A-5C}. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information to high-precision image data if necessary if higher precision image data is critical and cost is secondary to quality.

As for dep. claims 7, 8, 9 (part of 6), these are fairly taught in FUJI et al on Figs. 13-16, col. 13-14.

As for dep. 12 (part of 6), which has similar limitations as in dep. 13 above, it’s rejected for the same reasons set forth in dep. claim 13 above.

As for dep. 15 (part of 6), TAMURA et al discloses the communication with the user/client using portable cellular phone {see c9:47-50}. The use of other similar/equivalent portable phone for displaying images if desired would have been obvious as merely using other similar/equivalent device to achieve similar/equivalent

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results, absent evidence of unexpected results. Surely, an image display is normally better than a text/data display or would have been obvious if an image display is desired.

As for Independent method² 10, TAMURA et al /FUJI et al /DAWE discloses a written confirmation of the order print including detailed description of the order, thumbnail images, order information, price quotation, and any upgrades that have taken place {see DAWE page 2} and wherein the written confirmation are mailed to the customer the next morning. {see page 2, middle paragraph}. It would have been obvious to send the preview image of TAMURA et al /FUJI et al to another printer (voucher printer or written confirmation printer) to achieve the teaching as taught by DAWE above.

As for independent apparatus³ claim 1, which is the apparatus to carry out the method of claim 10, it's rejected over system of TAMURA et al /FUJI et al /DAWE to carry out the method steps as shown above in claim 10. Moreover, it would have been obvious to a skilled artisan, to select the appropriate system to carry out the steps of claim 10 as rejected over TAMURA et al /FUJI et al /DAWE above. Note that the order acceptance machine is shown in Fig. 4 (or Fig. 12) wherein the image printer is element (220 or 130), the voucher printer is element 212 and wherein the motivation for printing the thumbnail images in the voucher is cited in claim 10 above.

As for dep. claim 2 (part of 1), which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus

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claim which only gives patentable weight to system structural elements or structures.

Moreover, this is also taught in TAMURA et al as indicated in claim 10 above.

As for dep. claim 3 (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 13 (a), 13 (b), and/or Fig. 4 (224).

As for dep. claims 4, 5 (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Figs. 13(a), 13(b) or Fig. 12 or 9. Note also that the type of images received is non-essential to the scope of the claimed invention since it appears that it can receive any type of images.

As for dep. claim 16 (part of 1), which further limits the deals with the feature of the thumbnail images, this has no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. Moreover, this is taught in TAMURA et al col. 20, lines 40-49.

As for dep. claims 17-18 (part of 1), which deal with how the voucher printer operates, these have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

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7. Dep. claim 15 is rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over TAMURA et al /FUJI et al /DAWE as applied to claims 6-9, 12 above, and further in view of CONE et al or NARAYANASWAMY et al.

The teachings of TAMURA et al/FUJI et al /DAWE is cited above. TAMURA et al teaches the communication with the user/client using portable cellular phone {see c9:47-50}. CONE et al or NARAYANASWAMY et al is cited to teach the use of portable cellular phone with screen for viewing of virtual image of video information received via a wireless communication network {see CONE et al Fig. 1, or 2 or [0004, 0021], or NARAYANASWAMY et al Fig. 1A, 1B or Fig. 4, col. 2, lines 20-30}. It would have been obvious to modify the portable cordless phone of TAMURA et al /FUJI et al /DAWE by using portable cellular phone with screen for viewing of virtual image of video information received via a wireless communication network as taught by CONE et al or NARAYANASWAMY et al to allow viewing of virtual image of video information if desired.

No claims are allowed.

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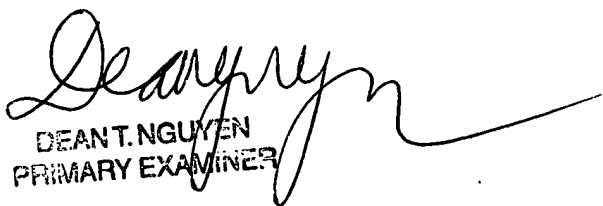
8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
December 27, 2005


DEANT. NGUYEN
PRIMARY EXAMINER